

REMARKS

Claims 7–14 and 17 were previously pending in this application. Claims 1–6 and 15–16 have been canceled without prejudice or disclaimer. Applicants respectfully request reconsideration of the Application in view of the foregoing amendments and the following remarks.

Claim Rejections – 35 U.S.C. § 102

Claims 7–11, 13–14 and 17 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Castle et al., U.S. Patent No. 6,185,812 B1. Applicants respectfully submit that the pending claims are patentably distinct from the cited reference.

Amended independent claim 7 recites, inter alia:

A resin panel comprising: a resin panel body; and a film for insert molding used fixed in an injection molding mold arranged on a surface of said resin panel body, said film comprising: a resin film; a first binder layer formed on the surface of the resin film; a printed part formed on the first binder layer; and a second binder layer formed to seal said printed part in co-operation with the first binder layer . . . wherein the periphery of the resin film extends beyond the periphery of the first binder layer such that the entire surface of the first binder layer which faces the resin film directly contacts the resin film

Applicants submit that Castle et al. cannot anticipate amended independent claim 7 because it does not teach each and every element of this claim. See MPEP § 2131. Castle et al. disclose a method for making an electrically heated window comprised of at least two plies of glass (21, 22), at least one ply of interlayer material (23) and an electrically resistant heating area means, e.g., a busbar (6). Castle et al. are particularly concerned with obscuring the busbar (6) from external view by positioning the busbar (6) along the edge of the window and covering it with an obscuration band (20). In the Final Office Action dated June 14, 2006, the Examiner indicates that element 20 in Castle et al. is analogous to the resin panel body 2 disclosed in Applicants' invention. See Final Office Action, 6/14/06 p. 2. In June 14, 2006 Final Office Action, the Examiner also repeats the rejections made in the Office Action dated January 3, 2006, which

analogizes element 20 of Castle et al. to the resin film 5 of Applicants' invention. See Applicants' Response, 3/28/06, p. 2 (indicating Examiner's typographical error in January 3, 2006 Office Action). The January 3, 2006 Office Action also analogizes elements 20, 23 and 22, collectively, to the insert film (3) of Applicants' invention. See Office Action, 1/3/06, p. 3. Clearly, there is a discrepancy as to what feature of Applicants' invention the Examiner equates with element 20.

Either way, element 20 of Castle et al. is not analogous to the resin panel body (2) or the resin film (5) of Applicants' invention. Castle et al. do not disclose an insert film -- elements 20, 22 and 23, according to the Office Action dated January 3, 2006 -- "fixed in an injection molding mold arranged on a surface of said resin panel body." As shown in Figure 2, element 20 contains no mold and, in fact, is smaller than the element 23 (second binder layer), such that the insert film cannot possibly be fixed in a mold arranged on the surface of element 20 as disclosed by Applicants.

Furthermore, element 20 cannot be analogized to the resin film (5) of Applicants' invention. Specifically, element 20 does not have a periphery that "extends beyond the periphery of the first binder layer such that the entire surface of the first binder layer which faces the resin film directly contacts the resin film."

For at least the above reasons, Applicants respectfully submit that Castle et al. do not disclose, teach or suggest each and every element recited in amended independent claim 7 or claims 8-11, 13-14 and 17 depending therefrom. Accordingly, these claims define patentable subject matter over Castle et al. Applicants respectfully request withdrawal of this ground of rejection.

Claim Rejections – 35 U.S.C. § 103

Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Castle et al. Applicants respectfully submit that the pending claims are patentably distinct from the cited reference.

To establish a prima facie case of obviousness, a prior art reference must teach or suggest all the limitations of a claim. See MPEP § 706.02(j). The January 3, 2006 Office Action

Serial No. 09/626,811
Response dated August 31, 2006
Reply to Office Action of June 14, 2006

Docket No. 5000-4777

indicates that Castle et al. disclose "the resin panel described above" and states that although Castle et al. are silent as to a resin body and resin film made from polycarbonate, it would have been obvious to one having ordinary skill in the art to provide Castle et al. with a polycarbonate resin body and resin film. See Office Action, 1/3/06, p. 5. However, as noted above, Castle et al. do not disclose a "resin panel [as] described above" because Castle et al. cannot anticipate Applicants' amended independent claim 7. Nothing in Castle et al. teaches or suggests every element of dependent claim 12 and, therefore, such claim cannot be rendered prima facie obvious in view thereof.

For at least the above reason, Applicants submit that dependent claim 12 is patentably distinct from the cited reference. Accordingly, Applicants request withdrawal of this ground of rejection.

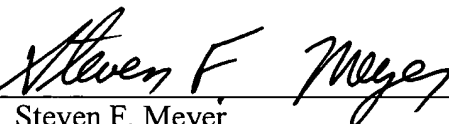
CONCLUSION

Based on the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: August 31, 2006

By:



Steven F. Meyer
Registration No. 35,613

Mailing Address:

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154-0053
(212) 415-8700 Telephone
(212) 415-8701 Facsimile